

REMARKS

I. INTRODUCTION

In response to the Office Action dated March 9, 2005, claims x-y have been amended. Claims x-y remain in the application. Entry of these amendments, and re-consideration of the application, as amended, is requested.

II. INTERVIEW SUMMARY

On March 28, and March 31, 2005, an interview was conducted between Examiner Roswell and Jason S. Feldmar. The validity of the prior art Net Meeting reference was described. No agreement was reached. Examiner Roswell agreed to forward case law in support of his position. Applicants appreciate the cooperation of the Examiner and acknowledge receipt of the relevant case law.

III. PRIOR ART REJECTIONS

On page (2) of the Office Action, claims 1-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over "Microsoft Windows NetMeeting 3", copyright date 1999, as shown at <http://www.microsoft.com/windows/NetMeeting/Corp/reskit/Copyright/default.asp>, and supported by <http://www.microsoft.com/windows/NetMeeting/Features/default.ASP>, NetMeeting, and "Markup File for Asynchronized Collaboration on an Image Viewer Application" by International Business Machines Corporation.

A. Prior Art Is Invalid

In response to the prior arguments with respect to the invalidity of the prior art date of the Microsoft Windows Net Meeting 3 reference, the final Office Action states that the document entitled "Resource Kit Copyright Information" demonstrates a copyright date of NetMeeting version 3 of 1999, which clearly predates the filing date of the application.

Subsequent to a telephone conference with the Examiner on March 31, 2005, the Examiner forwarded the case In Re Epstein 31 USPQ 2d 1817 (CAFC 1994) in support of the Examiner's position. Applicant appreciates the cooperation of the Examiner in forwarding the supporting case.

However, Applicants traverse the validity of the reference. Firstly, Applicants submit that there is a lack of evidence to support that the Net Meeting 3 software was released prior to the filing date of the present application. In this regard, the case law relied on specific facts to support the date. Namely, the abstract (that contained the information relied upon to reject the claims) provided a "first release" and "installed" dates, as well as the current number of users of the system (see 31 USPQ 2d 1817 at 1821-1823). Thus, the abstract itself offered clear evidence of the release date of the product described in the reference.

Applicants note that in the present prior art reference relied upon, the reference fails to describe any release date or install date. Instead, the reference merely provides a copyright date. Such a copyright date is not a release date or a date of installation. The mere citation of a copyright date for a reference does not and cannot be used to prove that software was released prior to that date. Again, it is unknown when the product was released or installed on any computer system. In addition, Applicants note that the Resource Kit is not the same as the Net Meeting 3.0 application itself. The whiteboard portion of the reference relied upon describes Net Meeting 3.0 and not the Resource Kit. However, the copyright information provided only relates to the Resource Kit. Accordingly, even if the copyright date is permissible to prove the release date of a software product, the copyright date relied upon in the Office Action would merely evidence the release date of the Resource Kit and not the Net Meeting 3.0 application itself.

In view of the above, Applicants submit that the Net Meeting 3.0 reference relied upon is invalid and cannot be used to reject the current claims.

B. The Independent Claims are Non-Obvious in View of the Cited References

As stated above, Applicants traverse the use of NetMeeting as a valid prior art reference. However, despite the inapplicability of the reference, Applicants submit that the amended claims are patentable over NetMeeting.

The independent claims were rejected as follows:

Regarding claims 1 and 20, NetMeeting teaches receiving, in a first client, an identification of a second client to initiate a chat session with, initializing a chat session across a network between the first client and the second client, displaying a graphical image on the first client (all taught as part of the video and audio conferencing capabilities of NetMeeting, on page 2 and the chat feature of page 3), selecting a command to markup the graphical image (taught as the use of selectable drawing tools on a shared Whiteboard, on page 4), and transmitting the markup file across the network to the second client through the chat session (inherent to the program to allow users at different workstations to view edits to the graphical images).

NetMeeting does not explicitly teach in response to the command, storing markup information in a markup file separate from the graphical image, wherein the markup information comprises a markup entity, a source reference that identifies the graphical image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity.

IBM teaches the use of a markup file for use on an image viewer application, such as the Whiteboard of NetMeeting. Furthermore, IBM shows storing markup information in a markup file separate from the graphical image (the script file of page 2), wherein the markup information comprises a markup entity (the markup information of page 2), a source reference that identifies the graphical image (inherent in the markup script data of page 2), and an orientation that indicates how the graphical image should be displayed with regard to the markup entity (the markup script information such as coordinates, rotation, and scaling of page 2).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of NetMeeting and IBM before him at the time the invention was made to modify the chat and Whiteboard portions of the NetMeeting application to include the markup file capability of IBM in order to obtain a chat and image conferencing system where image markup may be stored separately from the original image.

One would be motivated to make such a combination for the obvious advantage of storing image markup separately from the original image.

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Regarding claim 11, NetMeeting inherently teaches a first client computer and a display device connected to the first client computer. Furthermore, any modern-day computer with storage means is capable of storing a graphical image. NetMeeting shows an instant messaging application installed on a first client computer (the chat capabilities of page 3) and allows for a selectable command to markup a graphical image (the Whiteboard of page 4). Through the use of such chat and Whiteboard capabilities, NetMeeting allows for receiving an identification of a second client to receive the markup file, initializing a chat session across a network with the second client, transmitting the markup file across the network to the second client, transmitting the markup file across the network to the second client through the chat session, and displaying the markup entity in the orientation on the graphical image on the display device.

Net Meeting fails to explicitly teach in response to the command, storing markup information in a markup file stored separately from the graphical image, wherein the markup information comprises a markup entity, a source reference that identifies the graphical image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity.

IBM teaches the use of a markup file for use on an image viewer application, such as the Whiteboard of NetMeeting. Furthermore, IBM shows storing markup information in a markup file separate from the graphical image (the script file of page 2), wherein the markup information comprises a markup entity (the markup information of page 2), a source reference that identifies the graphical image (inherent in the markup script data of page 2), and an orientation that indicates how the graphical image should be displayed with regard to the markup entity (the markup script information such as coordinates, rotation, and scaling of page 2).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of NetMeeting and IBM before him at the time the invention was made to modify the chat and Whiteboard portions of the NetMeeting application to include the markup file capability of IBM in order to obtain a chat and image conferencing system where image markup may be stored separately from the original image.

One would be motivated to make such a combination for the obvious advantage of storing image markup separately from the original image.

Regarding claims 3 and 22, it can be seen in the NetMeeting image of page 4 that image markup commands are selectable from a menu.

Regarding claims 6 and 25, NetMeeting and IBM do not explicitly teach the use of XML for conveying markup information. However, XML files are well known in the art to give a user the flexibility of tag customization for specific information.

Claim 13, it can be seen in the NetMeeting image of page 4 that image markup commands are selectable from a menu.

Claim 16, NetMeeting and IBM do not explicitly teach the user of XML for conveying markup information. XML files are well known in the art to give a user the flexibility of tag customization for specific information.

Applicant traverses the above rejections. Specifically, none of the cited references teach, disclose, or suggest a markup entity that specifies a type of markup to be displayed.

Independent claims 1, 11, and 20 are generally directed to marking up a graphical image in a chat session. After displaying a graphical image and selecting a command to markup the image, a separate markup file is created with markup information. The markup information comprises various items including a markup entity that specifies a type of markup to be displayed. The information also includes a source reference and an orientation. The markup file is then transmitted across a network through the chat session and used to display the markup entity at the second client.

In rejecting these claims, the Office Action combines the Whiteboard portion of NetMeeting with the IBM reference markup file. However, neither reference, either alone or in combination, teaches, describes, suggests, or alludes to, explicitly or implicitly, a markup entity that specifies a type of markup to be displayed. In rejecting the markup entity of the original claims, the Office Action equated the markup entity to the markup information of the IBM reference. However, the markup information of the IBM reference provides "X-Y coordination, rotation, scaling markup characters and etc." However, the type of markup entity is not taught nor suggested in IBM. In this regard, scaling markup characters are not a type of markup to be displayed. Instead, they are the actual characters to be displayed. The actual characters are not a type of markup.

In addition, a "markup entity" is an "entity" or a unit and is more than just markup information or markup characters. As used in the specification, the markup entity can be a balloon markup entity, a cloud markup entity, an ellipse markup entity, a poly-line markup entity, a rectangle markup entity, and a text markup entity, etc. Such types of markup entities are clearly distinguishable and nonobvious from mere markup characters as set forth in IBM.

Thus, Applicant submits that independent claims 1, 11, and 20 are allowable over <http://www.microsoft.com/windows/NetMeeting/Corp/reskit/Copyright/default.asp> and supported by <http://www.microsoft.com/windows/NetMeeting/Features/default.ASP>.

Further, dependent claims 2-10, 12-19, and 21-29 are submitted to be allowable over <http://www.microsoft.com/windows/NetMeeting/Corp/reskit/Copyright/default.asp> and supported by <http://www.microsoft.com/windows/NetMeeting/Features/default.ASP> in the same manner, because they are dependent on independent claims 1, 11, and 20, respectively, and because they contain all the limitations of the independent claims. In addition, dependent claims 2-10, 12-19, and 21-29 recite additional novel elements not shown by <http://www.microsoft.com/windows/NetMeeting/Corp/reskit/Copyright/default.asp> and supported by <http://www.microsoft.com/windows/NetMeeting/Features/default.ASP>.

With respect to dependent claims 3, 13, and 22, the amended dependent claims provide for selecting the command from a menu that provides the ability to select from multiple markup entities to use to markup the graphical image. In rejecting these claims, the Office Action relied upon the image on page 4 of NetMeeting. However, the image on page 4 of NetMeeting does not show the use of a command to select from multiple markup entities whatsoever. Instead, the image merely shows a Whiteboard application with menu options of "File", "Edit", "View", "Tools", "Options", and "Help". Such commands do not teach, describe, or suggest, explicitly or implicitly, the ability to select a command to markup a graphical image from a menu. Further, such menu choices as illustrated on Page 4 do not provide the ability to select from multiple markup entities. Accordingly, Applicants submit that these claims are allowable over the cited art.

Amended dependent claims 6, 16, and 25 provide that the markup information is in XML and specifies a markup entity tag, a source reference tag, and an orientation tag. In rejecting these claims, the Office Action took OFFICIAL NOTICE that XML files are well known in the art to give a user the flexibility of tag customization for specific information. Applicants agree that XML files are well known in the art and provide flexibility for tag customization. However, the amended claims provide for the use of specific tags. Namely, a markup entity tag specifies a markup entity, a source reference tag identifies the graphical image, and an orientation tag specifies the orientation. While XML in general provides for the flexible use of tags, the specifically claimed tags are not obvious nor used in any of the cited references. In addition, Applicants note that neither of the

cited references even remotely suggest the use of XML. Accordingly, even if XML is known in the art, the suggestion or motivation to use XML in combination with NetMeeting or IBM is completely lacking. Applicants submit that there would be no motivation to use XML with the NetMeeting application or with the IBM application. In view of the above, Applicants submit that these dependent claims are allowable over the cited references.

IV. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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By their attorneys,

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